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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Steven L. Rohall

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05/29/2009

LOTUS AND RATIONAL SOFTWARE

David A. Dagg, Esq.

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EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3685

NOTIFICATION DATE

DELIVERY MODE

05/29/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

dave@davedagg.com

Office Action Summary	Application No. 09/995,151	Applicant(s) ROHALL ET AL.	
	Examiner JOHN M. WINTER	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5,9,13-16 and 19-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5,9,13-16 and 19-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

The Applicants amendment filed on March 17, 2009 is hereby acknowledged, Claims 3-5, 9, 13-16 and 19-38 are pending. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 17, 2009 has been entered.

Response to Arguments

Applicant's arguments with respect to the pending claim have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 3-5, 9, 13-16 and 19 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Claims 3-5, 9, 13-16 and 19 are rejected based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to

another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed. In this particular case, claim 3 fails prong (1) because the “tie” (e.g. electronic messages) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing. Claims 4-5, 9, 13-16 and 19 are either dependant upon claim 3 or contain similar limitations and are rejected for at least the same reasons.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3-5, 9, 13-16 and 19-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gay, (US Patent 6,792,145) in view of Rackman (US Patent No 5,903,646), and further in view of Newman et al (US Patent Application Publication 2004/0205535) and further in view of Kennedy (US Patent 6,330,589).
3. As per claim 3, 9, 13 and 19
Gay ('145) discloses in a computer system operatively coupled to a network and capable of executing a communication process for sending and receiving electronic mail documents, a method comprising:
 4. creating a shadow document from an original document, wherein the original document is an electronic mail message within a conversation thread of electronic mail messages,
(Figure 2 – Examiner notes “wherein the original document is... “is directed towards non functional descriptive information and it has been held such information will not distinguish a claimed device from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01))
 5. parsing the original document for selected logistical data comprising any of sender, receiver, original size, subject, or carbon copies of the original document, and storing the logistical data in the shadow document; (Column 7, line 29 – Column 8, line 10)
Gay ('145) does not explicitly disclose identifying, within the conversation thread of electronic mail messages, a parent document and a child document of the original

document, wherein the original document is a reply to the parent document of the original document and wherein the child document of the original document is a reply to the original document, and storing references thereto in the shadow document;. Rackman ('646) discloses identifying, within the conversation thread of electronic mail messages, a parent document and a child document of the original document, wherein the original document is a reply to the parent document of the original document and wherein the child document of the original document is a reply to the original document, (Column 8, lines 47-52 – Examiner notes “wherein the original document is... “ is directed towards non functional descriptive information and it has been held such information will not distinguish a claimed device from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01) and storing references thereto in the shadow document; (Column 8, lines 15-17; figure 4A). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Gay ('145) method with the Rackman ('646) in order to create a redundant data archive so that the document could be retrieved in the event of primary system failing.

Gay ('145) does not explicitly disclose determining and visually rendering a complete tree representing the conversation thread of electronic mail messages responsive at least in part to the shadow document Newman et al ('535) discloses determining and visually rendering a complete tree representing the conversation thread of electronic mail messages responsive at least in part to the shadow document,(Paragraph 34). It would be obvious to one having ordinary skill in the art at the time the invention was made to modify the Gay ('145) method

in view of Newman et al ('535) in order to create a data view that allowed for identification of discrepancies between the documents.

Gay ('145) does not explicitly disclose wherein the rendering of the complete tree representing the conversation thread of electronic mail messages represents the original document as a child of the identified parent document and as a parent of the identified child document, and wherein a structure of the complete tree representing the conversation thread of electronic mail messages is preserved after deleting of the original document.

Kennedy ('589) discloses wherein the rendering of the complete tree representing the conversation thread of electronic mail messages represents the original document as a child of the identified parent document and as a parent of the identified child document, and wherein a structure of the complete tree representing the conversation thread of electronic mail messages is preserved after deleting of the original document. (Column 10, lines 9-39, Figure 4b – Examiner notes that one copy of message is left on the server, another downloaded to the client, analogous to the parent and child databases when downloaded missing messages are replaced with placeholders (fig 7C) Examiner notes that the language “wherein the rendering of the complete tree...” is directed towards non functional descriptive information and it has been held such information will not distinguish a claimed device from the prior art (*In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01), furthermore the language of “wherein a structure of the complete tree representing the conversation thread of electronic mail messages is preserved after deleting of the original document” is merely stating the result of an action. A (whereby/wherein) clause that merely

states the result of the limitations in the claim adds nothing to the patentability or substance of the claim (Texas Instruments Inc. v. International Trade Commission 26, USPQ2d 1010 (Fed. Cir. 1993); Griffin v. Bertina, 62 USPQ2d 1431 (Fed. Cir. 2002); Amazon.com Inc. v. Barnesandnoble.com Inc., 57 USPQ2d 1747 (CAFC 2001)). It would be obvious to one having ordinary skill in the art at the time the invention was made to modify the Gay ('145) method in view of Newman et al ('535) in order to create a data view that allowed for identification of discrepancies between the documents.

6. Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See e.g. MPEP §2106 II C: "Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.

7. As per claim 4,

Gay ('145) discloses the method of claim 3 wherein "A" further comprises:
filtering the original document for selected content.(Figure 2)

8. As per claim 5,

Gay ('145) discloses the method of claim 3

Gay ('145) does not explicitly disclose wherein the shadow document further comprises selected data from the content of the original document. Rackman ('646) discloses wherein

the shadow document further comprises selected data from the content of the original document. (Figure 4A). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Gay ('145) method with the Rackman ('646) in order to create a redundant data archive using the original content so that the document could be retrieved in the event of primary system failing.

9. As per claim 14,

Gay ('145) discloses the method of claim 13

wherein at least one of the plurality of presented documents is an original document.(Figure 5)

10. As per claim 15,

Gay ('145) discloses the method of claim 13

wherein at least one of the plurality of presented documents is a shadow document.(Figure 5)

11. As per claim 16,

Gay ('145) discloses the method of claim 1 further comprising:

resolving the reference in a shadow document to one of the parent and child document, and maintaining in memory data identifying a plurality of shadow documents and any parent and child documents thereof.(Figure 2)

12. Claims 20-38 are in parallel with the above rejected claims and are rejected for at least the same reasons

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Supervisory Patent Examiner, Art Unit 3685